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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,775	06/29/2001	Will H. Gardenswartz	OBSP5GARD-USC2	5962

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/893,775	GARDENSWARTZ ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 November 2005* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,55 and 57-87* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,55 and 57-87* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 May 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 18 November 2005 have been fully considered but they are largely moot in view of the following new basis of rejection for all claims except claim 1. The pertinent arguments are addressed at para. 8-10, 15-17 and 21 below. This Office action has been made non-final because the previous rejection of claim 70 was found to be deficient (by relying on a provisional application that had not been sent to applicant, and which in any event did not contain the claimed limitation).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 1 is rejected under 35 USC 103(a) as obvious over Biorge et al. in view of Stein et al. (US pat. 5,459,306) and Herz et al.

4. Biorge et al. teaches a method for delivering *incentive credits,* which reads on targeted advertising, comprising: receiving from a first computer *(the portable device)* a first identifier *(encrypted signals)* identifying the first computer, and associated with an observed offline purchase history of a consumer, including purchase information collected when the purchase transpired, and selecting and electronically delivering the credits/ targeted advertising to the consumer at the first computer in response to receiving the first identifier (col. 5 lines 2-3 and 23-29). The credits in the first computer are derived from and therefore associated with an observed offline purchase history of a consumer.

5. Biorge et al. also teaches that some offline purchases, which reads on said offline purchase, are not transacted with the first computer. A "purchase" is an exchange for money or its equivalent (Merriam-Webster's Collegiate Dictionary). The first computer is used to transact an offline purchase only when credits are available (on the first computer) and used to pay at least part of

the purchase price. The reference teaches (col. 5 lines 29-33) that presently accrued credits are not applicable to present purchases. Hence, when the only credits available are presently accrued credits, the first computer is not used to transact the purchase.

6. Biorge et al. does not teach that that the first identifier is associated by a purchase behavior classification with the observed purchase history of a consumer. Stein et al. teaches that the first identifier (*user code*, col. 2 lines 65-66) is associated by a purchase behavior classification with the observed purchase history of a consumer (col. 2 line 66 to col. 3 line 8). Because classification is statistically efficient, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Stein et al. to those of Biorge et al.

7. Biorge et al. does not teach that said selecting is made without providing to an advertiser said purchase history. Because Herz et al. teaches (col. 5 lines 34-43) that there is need to maintain confidentiality of the purchase history data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to make said selecting without providing to an advertiser said purchase history.

8. Applicant argues (p. 14-15) that Biorge et al. does not teach determining a targeted ad based on the consumer's offline purchase history. The *incentive credit* (col. 1 lines 38-49 and col. 5 line 27) is the ad because it advertises the *participating provider* (col. 1 lines 48-49). It is targeted at the specific customer (col. 2 line 21). It is based on the user's purchase history (previous *purchase transactions*, col. 1 lines 38-44). At least some of said previous transactions are offline because the reference teaches *most transactions may be conducted off-line* (col. 2 lines 35-36).

9. Applicant argues (p. 16-18) that there is no motivation to combine Stein et al. with Biorge et al. because the classification information is irrelevant to the purpose of Biorge et al. The justification for combining the references is the statistical efficiency of classification (para. 6 above). Applicant argues that Biorge et al. deals only with "credit information" (e.g., at p. 17 lines 2-3 from the bottom, and col. 18 line 2). Actually, Biorge et al. deals with *incentive credits*, which is to say promotional discounts (col. 5 lines 27-29). Classification would be helpful if, for example, the sponsor was interested in providing said credits to all consumers shopping in a particular pharmacy chain, or in a particular geographical region.

10. Applicant argues (p. 18-19) that there is no motivation to combine Herz et al. with Biorge et al. because Biorge et al. does not disclose or suggest categorizing a consumer based on product selections. While true, that is irrelevant. The justification for combining the references is maintaining confidentiality of the purchase history data (para. 7 above), said data being collected in Biorge et al. (col. 6 lines 38-44). The data are available for abuse, for example revealing to sponsor Walgreen that the customer routinely shops at competitor CVS. Herz et al. teaches making the targeted ad/credits selection so as to prevent this abusive disclosure of customer data.

11. Claims 55, 57-69 and 71-87 are rejected under 35 USC 103(a) as obvious over Stein et al. (US pat. 5,459,306) in view of Merriman et al. (US005948061A).

12. Stein et al. teaches (independent claims 55, 86 and 87) a computer network implemented method and system for delivering targeted advertisements, the method comprising: collecting a first consumer/customer/*user* offline purchase history and identification (col. 2 lines 42-43 and 65-66); storing said consumer/customer/*user* information (col. 4 lines 14-19); (inherently) receiving from *kiosk* ***5*** its network address, which reads on a "consumer computer first identifier", sending said kiosk network address with the *user code*/first consumer identification to the *coupon controller* ***9***, which reads on associating said first identifier/kiosk network address with said first consumer identification/*user code*, and determining a targeted advertisement (*targeted promotions*, col. 1 lines 10-12 and *announcements*, col. 4 lines 60-61) for said first consumer based at least in part on said offline purchase history associated with said first consumer identification/*user code* with said first identifier/*kiosk* ***5*** its network address (col. 6 lines 28-51); and delivering said determined targeted advertisement to said first consumer (col. 6 lines 55-57).

13. Stein et al. does not teach that said consumer computer is at the consumer's home or office. Merriman et al. teaches a *PDA* ***16*** (col. 3 lines 23-27), which reads on a consumer computer at the consumer's home or office. Because Stein et al. teaches that it is important to keep consumers/*users* from monopolizing a *kiosk* ***5*** consumer computer (col. 6 line 59), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Merriman et al. to those of Stein et al. Stein et al. teaches a local area network (*Ethernet*, col. 6 line 40) joining the *kiosk* ***5*** consumer computers in each store (col. 5 lines 9-12) with ad/coupon controller **9** (col. 6 lines 37-45). Merriman et al. teaches a broader

Internet (col. 1 line 30) connecting any number of consumer computers *PDA* ***16*** to *ad server* ***19***. Because it would enhance consumer convenience and minimize the number of special and *kiosk* ***5*** consumer computers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to replace at least some of the *kiosk* ***5*** consumer computers with the *PDA* ***16*** consumer computers accessing coupons/ads over the Internet.

14. Stein et al. also teaches at the citations given above claims 59 (inherently), 64 (where *coupon controller* ***9*** reads on an advertiser's server) and 65-67.

15. Applicant argues (pp. 21 last line) that claims 64 is not taught by Stein et al, because the reference does not teach an advertiser's server as defined in the specification and that claim 65 is not taught (p. 22 first full para.).

16. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

17. The instant application contains no such clear definition for any terms, including "advertiser's server". In the instant case, the examiner is required to give this term its broadest reasonable interpretation, which is any server of ads. *Coupon controller* ***9*** taught by Stein et al. (col. 6 lines 37-54) reads on that. For claim 65, by the same logic, any mechanism that associates identifiers with corresponding consumer identifications is an association table.

18. Stein et al. also teaches claim 62 (col. 5 line 59), 68 and 72 (where *host system* ***13***, jointly with *coupon controller* ***9***, reads on said analytical computer because it provides *rules for predicting purchases*, col. 4 line 13 and col. 5 lines 9-12), 69 (col. 4 line 14),

19. Merriman et al. also teaches claims 63 (col. 3 lines 41-47 and col. 4 lines 1-2), and 73 and 74 (col. 7 lines 15-31, where the user response to an ad reads on registration).

20. Neither Stein et al. nor Merriman et al. teaches the purchase history data limitations of claims 57, 58, 60 and 61, IVR (claim 71) or sending a registration web page (claims 75-85). Official notice was taken (para. 15 of the Office action mailed on 6 June 2005) that all of the purchase history data limitations were commonly acquired and are of clear use to a retailer for product promotion, and also that IVR communication and web page registration were common at the time of the invention.

21. Traverse of the taking of Official Notice - On pp. 23-24, applicant has traversed the examiner's taking of official notice (para. 20 above). However, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.

22. Claim 70 is rejected under 35 USC 103(a) as obvious over Stein et al. (US pat. 5,459,306) in view of Merriman et al. (US005948061A), and further in view of De Lapa et al. US006076068A). Neither Stein et al. nor Merriman et al. teaches transmitting offline purchase history data in real time. De Lapa et al. teaches transmitting offline purchase history data in real time (*dynamically updated*, col. 9 lines 39-45). Because De Lapa et al. teaches that dynamic/real time updating enables greater profits (col. 3 lines 18-22), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of De Lapa et al. to those of Stein et al. and Merriman et al.

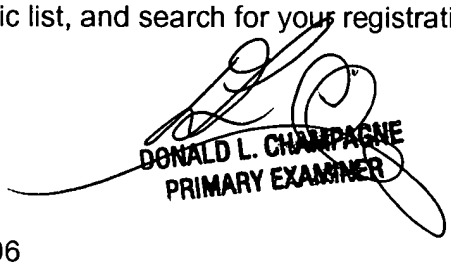
Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

24. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The phone number for all *formal* fax communications is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

26. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne
Primary Examiner
Art Unit 3622

20 February 2006